

Docket No. 4512/80212

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT:** Pharma Mar, s.a. et al.  
**SERIAL NO.** 09/787,461 (not recognized)  
**FILED:** 12 October 2001  
**FOR:** Compositions and Uses of ET743 for Treating Cancer  
**TOTAL PAGES:** 6 (including this cover sheet)  
**ATTN:** Examiner Yvonne R. Abbott  
**FACSIMILE NO.** (703) 308-6916 (Petitions Office - Patent)

**RECEIVED**  
APR 04 2002  
**GROUP 3600**

**FAX RECEIVED**

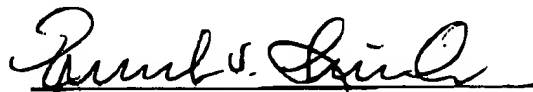
MAR 19 2002

PETITIONS OFFICE

**CERTIFICATE OF FACSIMILE TRANSMISSION**

The undersigned hereby certifies that the correspondence attached hereto, namely a Request for Clarification..., was filed by facsimile in the USPTO on the date shown below.

Respectfully submitted,



Ernest V. Linek (29,822)  
BANNER & WITCOFF, LTD.  
28 State Street, 28th Floor  
Boston, MA 02109-1775  
Tel. (617) 227-7111

Date: 19 March 2002

Document No. 79558

#4

Docket No. 4512/80212

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Response  
7-2-02

**APPLICANT:** Pharma Mar, s.a. et al.  
**APPLN. NO.:** PCT/GB00/01857 (designating the US)  
**FILED:** 15 May 2000  
**FOR:** Compositions and Uses of ET743 for Treating Cancer

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, DC 20231  
BOX DAC

FAX RECEIVED

MAR 19 2002

Sir:

PETITIONS OFFICE

**REQUEST FOR CLARIFICATION REGARDING THE DECISION DENYING  
APPLICANT'S PETITION FOR RETROACTIVE FOREIGN FILING LICENSE**

Applicant respectfully requests clarification of the attached communication from the Examiner regarding Applicant's petition for retroactive license under 35 U.S.C. §184.

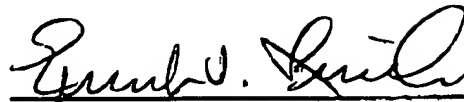
First - the U.S. Serial Number cited in the paper (U.S.S.N. 09/787,461) is not recognized either by the undersigned attorney or by UK counsel for the Applicant - Graham Ruffles.

It is believed that the national phase US Filing of PCT/GB00/01857 has been accorded U.S.S.N. 10/031,810. Clarification is requested.

Second - the mailing date of the paper is illegible. Please confirm the mailing date so that the response may be properly docketed.

Request for Clarification re the Pending  
Petition for Retroactive Foreign Filing License  
Page 2 of 2

Respectfully submitted,



Ernest V. Linek (29,822)  
Attorney for Petitioner  
BANNER & WITCOFF, LTD.  
28 State Street, 28th Floor  
Boston, MA 02109-1775  
(617) 227-7111

Date: 3/19/2002

Document No. 79555



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/787,461	12-Oct-01	PHARMA MAR, S.A. ET AL	4512/80212

Title: COMPOSITIONS AND USES OF ET743 FOR  
TREATING CANCER

## Correspondence Address:

ERNEST V. LINEK  
BANNER & WITCOFF, LTD.  
28 STATE STREET, 28TH FLOOR  
BOSTON, MA 02109

Art Unit	Paper Number
PATENT & TRADEMARK OFFICE	

MAR 1-21-02

RECEIVED  
MAR 07 2002  
E. V. LINEK

LICENSING &amp; REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.

FAX RECEIVED

MAR 19 2002

PETITIONS OFFICE

RECEIVED

MAR 07 2002

BANNER &amp; WITCOFF



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

In re: Pharma Mar, s.a. et al. :DECISION ON REQUEST  
Serial No.: 09/787461 :UNDER 37 CFR 5.25  
Petition Filing date: March 2, 2001  
Docket No.: 4512/80212

Title: COMPOSITIONS AND USES OF ET743 FOR TREATING CANCER

This is a decision on the petition filed March 2, 2001 for retroactive foreign filing license.

Decision: Denied

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

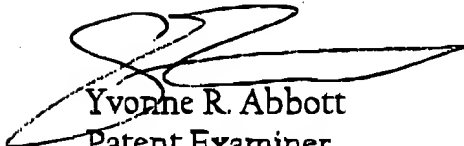
The petition is Denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(ii) and (iii) have not been met.

There appears to be no error as to why the material was first filed abroad. In the declaration of attorney Graham Ruffles, it states in ¶ 3 that "under UK patent law, there is no requirement to name the inventors". It appears that it was merely reliance on UK law and not lack of knowledge of the requirements of US laws that prevented the legal representatives from conducting a thorough investigation of inventorship. Not determining inventorship until later in the prosecution process

is not within the meaning of "error" as provided in 37 CFR 5.25(a)(3)(iii). A statement clarifying this issue is needed.

Furthermore, with respect to the issue of diligence, there is no explanation as to what the attorney did to pursue discovery of facts, or investigation of inventorship between 5/00 (when the US inventors were known) and the filing of the petition on 3/2/01 (almost a year later).

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is DENIED, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Yvonne R. Abbott  
Patent Examiner  
(703) 308-2866

03 308 6916

\*\*\*\*\*  
\*\*\* RX REPORT \*\*\*  
\*\*\*\*\*

RECEPTION OK

TX/RX NO	5246
CONNECTION TEL	617 227 4399
CONNECTION ID	
START TIME	03/19(TU)15:27
USAGE TIME	04'18"
PGS.	6
RESULT	OK

# INITIAL SCREENING OF INCOMING PAPERS CHECKLIST

Reviewer: K Chase

Date: 3-20-02 <sup>5</sup> <sub>3412</sub>

APPLICATION NO. 091787461

## 1. PETITION TYPE CODE

☐ R137(a) Petition-----501  
☐ R137(a) Petition -----509  
     (Issue Fee/Dwgs)  
☐ R137(b) Petition-----502  
☐ R137(b) Petition-----510  
     (Issue Fee/Dwgs)  
☐ R137(f) Petition-----536  
☐ R182 Petition-----519  
☐ R183 Petition-----503  
☐ R378(b) Petition-----532  
☐ R378(c) Petition-----533  
☐ R377 Petition-----521  
☐ R3.81(b) Petition-----523  
☐ R181 Petition-----515  
☐ R181 Petition-----504

## PETITION TYPE CODE

☐ R28c Peition-----309  
☐ R47 Petition-----313  
☐ R53(e) Petition-----408  
☐ R53 (R62 filing date)----410  
☐ R10 Petition-----411  
☐ Lost Application-----412  
☐ R78(a)(3) Petition-----535  
☐ R78(a)(6) Petition-----535  
☐ R55(c) Petition-----535  
☐ R314 Petition-----508  
☐ R55(a) Petition-----507  
☐ Pet. W/D Abn-----525  
☐ R705(b)/c-PTA-Bef iss-----550  
☐ R705(d) PTA-Aft iss-----551  
☐ Other \_\_\_\_\_

## 2. LIST PAPERS FILED WITH PETITIONS

<input type="checkbox"/> PreAmdt/Amdt	<input type="checkbox"/> CPA	<input type="checkbox"/> Associate POA
<input type="checkbox"/> Filing Fees	<input type="checkbox"/> RCE	<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Reply/Arguments	<input type="checkbox"/> IDS	<input type="checkbox"/> Change of Address
<input type="checkbox"/> Election	<input type="checkbox"/> 129(a) Submsn	<input type="checkbox"/> Revocation/Poa
<input type="checkbox"/> Notice of Appeal	<input type="checkbox"/> Issue Fee	<input type="checkbox"/> Priority Documents
<input type="checkbox"/> Brief (3)	<input type="checkbox"/> Drawings	<input type="checkbox"/> Oath/Decl. & POA
<input type="checkbox"/> Reply Brief	<input type="checkbox"/> Oath/Decl & POA	<input type="checkbox"/> Rule 312 Amdt
<input type="checkbox"/> Declaration R132	<input type="checkbox"/> Ext Time ( )	

Other Papers \_\_\_\_\_

3. Is paper a petition to withdraw holding of abandonment: yes no  
 If so, send paper and/or file to appropriate location (Note: remove any flag set first):

- a. Nonreceipt of action from TC or assertion that reply was timely filed:  
 Send paper to TC \_\_\_\_\_
- b. Nonreceipt of Missing Parts Notice or assertion that reply was timely filed:  
 Send paper to DIRECTOR -OIPE --CP2-7D25 (PH: 308-0910)
- c. Assertion of timely payment of issue fee and/or submission of drawings:  
 Send petition to Office of Publications: ATTN: Tom Hawkins
- d. Other \_\_\_\_\_

4. Other: TC 3640

If not handled in Office of Petitions, send paper to appropriate location.

5. Is petition accompanied by assignment papers, fee address, or other paper which needs to be sent to another location? yes no If so, make copy of assignment papers, fee address, or other paper; mail original to proper location and place copy in file with an indication that the original paper(s) has been forwarded to the appropriate location (Assignment Branch; Maintenance Fee Division, etc.)

RECEIVED

APR 04 2002

GROUP 3600